



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,716	02/26/2001	George N. Pavlakis	15280-3521US	4088

20350 7590 06/23/2004

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

WINKLER, ULRIKE

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/673,716	<b>Applicant(s)</b> PAVLAKIS ET AL.	
	<b>Examiner</b> Ulrike Winkler	<b>Art Unit</b> 1648	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on March 25, 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) 31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7 is/are ~~allowed~~ allowable.
- 6) ☒ Claim(s) 1,8-27,32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1648

### **DETAILED ACTION**

The Amendment filed March 25, 2004 in response to the Office Action of October 21, 2003 is acknowledged and has been entered. Claims 28, 29 have been cancelled. Claims 1-27 and 32-33 are pending and are currently being examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

In order to facilitate the prosecution of this application, Applicant is requested to cancel all non-elected embodiments from the claims.

### ***Specification***

The Office acknowledges the change to the title of the invention.

The amendment to the specification indicating the priority information needs to include the information that the application is the U.S. national phase under U.S.C. § 371 of international application. Correction is requested.

### ***Claim Objections***

The objections of claim 1-30 because of the following informalities: The claims use abbreviations such as "PRE" or "NCTE", for the sole purpose of clarity the first time the abbreviation is used in a claim set beginning with an independent claim the full term should be used **is withdrawn** in view of Applicant's amendment to the claims.

The objection of claim 1 **is withdrawn** in view of Applicant's amendment to the claims.

***Claim Rejections - 35 USC § 112***

The rejection of claims 28 and 29 provides for the use of a PRE, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass **is withdrawn** in view of Applicants cancellation of the claims.

The rejection of claims 28 and 29 under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101 **is withdrawn** in view of Applicants cancellation of the claims.

The rejection of claim 21-29 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention **is withdrawn** in view of Applicant's amendment to the claims.

The rejection of claims 2-14, 16-30 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention **is withdrawn** in view of Applicant's arguments indicating that SEQ ID NO:6

Art Unit: 1648

of the instant application is an example of a PRE sequent that has function and has 83% sequence identity with SEQ ID NO:1.

***Claim Rejections - 35 USC § 102***

The rejection of claim 1 under 35 U.S.C. 102(a) as being anticipated by Gene bank Accession # C80740 or C80177 **is maintained.**

The declaration filed on March 25, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Gene Bank reference, because the declaration was not signed by both inventors.

**New Rejections:**

Claim 27 is objected to because of the following informalities: The claim refers to itself in the body of the claim "the kit of claims 27". Appropriate correction is required.

Claims 1, 8-27, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the term "capable of", recited specifically in claims 1, 8, 12, 21, 26, 30 and 33, it is not clear whether the compound actually has to have the specified function or not. The term "capable of" does not provide any indication that the compound has to have any particular activity at all. Therefore, the term "capable of" does not provide any indication of what the compound has to actually accomplish in order to be within the scope of the claim.

Art Unit: 1648

***Conclusion***

Claims 1, 8-27 and 32-33 are rejected.

Claims 2-7 are allowable.

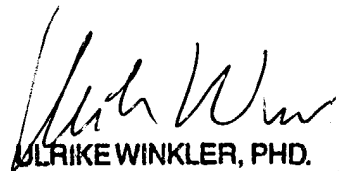
Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989). The Group 1600 Official Fax number is: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center representative whose telephone number is (571)-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 571-272-0912. The examiner can normally be reached M-F, 8:30 am - 5 pm. The examiner can also be reached via email [ulrike.winkler@uspto.gov].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 571-272-0902.

  
ULRIKE WINKLER, PHD.  
PATENT EXAMINER 6/24/04